



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/855,584

05/16/2001

Thomas M. Collins

21175-002001

1405

26211 7590 06/30/2010

FISH & RICHARDSON P.C.

P.O. BOX 1022

MINNEAPOLIS, MN 55440-1022

EXAMINER

BATURAY, ALICIA

ART UNIT

PAPER NUMBER

2446

NOTIFICATION DATE

DELIVERY MODE

06/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. COLLINS, KEVIN L. RABINOVITCH,
NEIL A. WILLCOCKS, MARK J. CHIMEL, HENRY V. IZZO and
ROBERT W. TUTTRUP

Appeal 2010-000728
Application 09/855,584
Technology Center 2400

Oral Hearing Held: June 8, 2010

Before JAY P. LUCAS, STEPHEN C. SIU, and DEBRA K. STEPHENS
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

SAMUEL BORODOCH, ESQ.
Fish & Richardson, P.C.
P.O. Box 1022
Minneapolis, Minnesota 55440

1 THE USHER: Calendar No. 11, Appeal No. 2010-000728, Mr.
2 Borodoch.

3 JUDGE LUCAS: Thank you, Pat. Samuel Borodoch?

4 MR. BORODOCH: Yes.

5 JUDGE LUCAS: Can you give Mr. Carr your card, if you have
6 one. Samuel Borodoch. B-o-r-o-d-o-c-h.

7 MR. BORODOCH: I apologize. I actually don't seem to have
8 one on me. My apologies.

9 JUDGE LUCAS: I just spelled it out. Welcome,
10 Mr. Borodoch. We have conveniently not given you a clock on the wall. It's
11 totally at our discretion when the 20 minutes ends.

12 MR. BORODOCH: Understood.

13 JUDGE LUCAS: I'll try to give you a warning and tell you it's
14 time to sum up at the end. You may be interrupted by questions at any time.

15 MR. BORODOCH: Thank you very much.

16 JUDGE LUCAS: Please start.

17 MR. BORODOCH: If it pleases this Honorable Board, the
18 invention claimed in the present application relates to the transmission of
19 electronic mail and particularly to the handling of attachments to e-mail
20 messages.

21 As the use of e-mail messages with attachments has
22 proliferated, the load on the networks or other systems carrying the
23 messages increases significantly. Reducing unnecessary network capacity is
24 therefore highly desirable.

25 Claim 23 is an exemplary independent claim that recites a
26 method for transmitting electronic mail from a sender to multiple recipients.
27 The method includes designating at least one recipient to receive a message
28 and an attachment, designating at least one recipient to receive the message
29 without the attachment.

30 The method also includes enabling a recipient to create and edit
31 a reception profile which indicates the recipient's preferences with regard to
32 receipt of prospective attachments.

1 Of particular importance is the claim feature about the reception
2 profile which is created and edited by a recipient and impacts the
3 transmission process at the sender or transmission side.

4 In particular, as we recited, for example, in Claim 23, the
5 message is transmitted from the sender without the attachment to any
6 recipient whose reception profile specifies not to receive an attachment.
7 Thus, regardless of whether or not the sender designated the recipient to
8 receive the attachment, the message is transmitted from the sender without
9 the attachment if the recipient reception profile indicates that the recipient
10 does not wish to receive such an attachment.

11 Benefits of the claimed invention include, for example,
12 reducing the load of a network environment and avoiding unnecessary use of
13 network capacity.

14 The Examiner finally rejected Claim 23 and other claims as
15 obvious from a combination of three references, Foladare, Redpath and
16 Beck.

17 The rejection should be reversed because none of the references
18 discloses or renders obvious a method in which the recipient side impacts
19 transmission processes at the sender or transmission side. Instead, the cited
20 references disclose attachment related processes that take place either
21 exclusively on the recipient side or exclusively on the sender side.

22 Specifically, Foladare allows only for the recipient side to
23 control the recipient side decisions, and Redpath and Beck allow only for the
24 sender or transmission side to control the sender side decisions.

25 Therefore, even if the disclosures in the references were
26 somehow combined, a person of ordinary skill would have had no reason to
27 modify the references so as to obtain the claimed subject matter.

28 Allow me to address the references in greater detail. Foladare
29 discloses an e-mail distribution system that allows a user having incoming
30 e-mail to be distributed to multiple receiving devices such as personal
31 computers, PDAs or pages. When the incoming e-mail is sent from a sender
32 to a user with attachments, the e-mail distribution system distributes the

1 e-mail out to the receiving devices with all, some or no attachments,
2 depending on, for example, the type of receiving device.

3 In particular, Foladare discloses a centralized electronic mail
4 device that receives an e-mail message from a sender's device and distributes
5 that e-mail to a variety of other devices according to information stored in a
6 profile database.

7 In other words, distribution of the e-mail in accordance with
8 information in the centralized e-mail device occurs only after the e-mail has
9 been transmitted from the sender's device to the centralized e-mail device
10 with the attachment.

11 Therefore, Foladare allows for the recipient side of the system
12 to impact the distribution of messages on the reception side. The
13 information stored in the profile database in Foladare does not impact
14 whether or not attachments are transmitted from the sender's device.
15 Instead, the decision to send the e-mail message with or without the
16 attachment and in particular, to load an e-mail onto the network with or
17 without the attachment, is made exclusively at the sender or transmission
18 side, and is unaffected by information at the recipient side, including the
19 centralized electronic mail device.

20 Foladare's centralized electronic mail device does not and
21 cannot impact whether or not the e-mail is transmitted from the sender's side
22 with or without an attachment. Indeed, Foladare does not even recognize the
23 possibility of controlling sender side decisions from the recipient side.

24 Let me turn to the second reference cited by the Examiner.
25 Redpath discloses an e-mail notification process with a new addressee line
26 identifier that allows an e-mail sender to notify additional addressees of what
27 has been sent to the primary addressee without slowing down transmission
28 time or wasting storage space by including unneeded and possibly large
29 attachment files.

30 On the sender or transmission side, Redpath's new addressee
31 line identifier allows an e-mail sender to send an icon to indicate an
32 attachment has been sent to another user. However, the sender alone and not

1 the addressee, not the recipient, controls which addressee line identifier is
2 used.

3 Thus, the transmission process is controlled in Redpath entirely
4 at the sender or transmission side. Therefore, whether or not a recipient
5 receives an attachment is controlled by the sender exclusively.

6 There is nothing in Redpath to suggest that any action that the
7 recipient side impacts whether a message is transmitted from the sender with
8 or without an attachment.

9 Let me turn now to the third reference cited by the Examiner,
10 Beck.

11 Beck discloses a method for transmitting e-mail attachments by
12 replacing the attachment at the sender's side with an attachment reference.
13 Thus, instead of transmitting the attachment, a reference or pointer is
14 transmitted with the message, whereas the attachment itself is stored locally.

15 At the recipient side, a user can later access the attachment by
16 clicking on the attachment reference.

17 As relevant here, Beck is similar to Redpath. Whereas, Redpath
18 discloses sending an attachment icon in place of the attachment, Beck
19 discloses sending an attachment reference or a pointer in place of the
20 attachment.

21 In Redpath and Beck, replacement of the attachment with an
22 icon or attachment reference is based solely on the decision at the sender or
23 transmission side. Whether or not the attachment to the e-mail is sent is not
24 based on the reception profile created by a recipient as cited in the
25 independent claims.

26 Thus, Beck like Redpath, does not disclose that transmission of
27 an attachment from the sender to a recipient is impacted by a reception
28 profile created by a recipient.

29 Even if there was some reason to combine Foladare, Redpath
30 and Beck, at most, that might suggest replacing an e-mail attachment either
31 with an attachment icon as in Redpath or with an attachment reference as in

1 Beck. In any event, the replacement of an attachment still would be
2 independent of information from the recipient side.

3 The Examiner's Answer alleges incorrectly that the claimed
4 language does not require that the recipient's reception profile impact the
5 transmission process at the sender or transmission side. This is contrary to
6 the plain language of the claims which recite that a message is transmitted
7 from the sender without the attachment to any recipient whose reception
8 profile specifies not to receive an attachment. This is regardless of whether
9 the sender designated the recipient to receive the attachment or not.

10 In summary, the rejection of the claims based on the
11 combination of Foadare, Redpath and Beck should be reversed.

12 JUDGE LUCAS: I'm sorry, I thought you were summarizing.

13 MR. BORODOCH: Summarizing the first point. I'd like to
14 address some of the dependent claims.

15 JUDGE LUCAS: Let's pause for a second. I forgot to
16 introduce Judge Stephens from North Carolina who is joining us.

17 JUDGE STEPHENS: Hello.

18 MR. BORODOCH: Good morning.

19 JUDGE LUCAS: Do either of you have any questions at this
20 point?

21 JUDGE SIU: No questions.

22 JUDGE STEPHENS: I do. I would like to know where you
23 have support for the sender being just the device and not including the entire
24 network up until the recipient. Is there support in your spec for that?

25 MR. BORODOCH: I think that would be the sender and the
26 specification discloses various hardware and software based components of
27 the system, which make it readily clear that in the context of this application,
28 the claim language when it uses "sender" is clearly referring to -- it could be
29 the initial sender device that an individual is using, but to interpret "sender"
30 in the context of the pending claims, as including the entirety of a system,
31 other than the recipient, would not make any sense, particularly when one
32 contrasts that with the prior art, particularly, for example, Foadare, which is

1 the primary reference cited, the centralized electronic mail device, number
2 160 in Figure 1 of Foladare, is connected to the sending party user's device,
3 number 100, only by way of the network.

4 It's clear to interpret the centralized electronic e-mail device in
5 Foladare, for example, as being somehow part of the sending device or the
6 device 100 that the sending party uses. It is contrary to the specification in
7 its entirety in the pending application and it is clearly inconsistent with
8 Foladare, which makes it clear the centralized electronic mail device is on a
9 different part of the network or the system, it can only be accessed by a user
10 device or the recipient devices by going through the network itself.

11 Therefore, even if in some circumstances, in the present
12 application, the sender could be interpreted to include something other than
13 the sender's device, it certainly could not be extended to include the
14 centralized electronic mail device of Foladare.

15 JUDGE LUCAS: Can the sender be a device?

16 MR. BORODOCH: I think in the context of the application,
17 that would not be inconsistent. Some of the claims I've been focusing on --

18 JUDGE LUCAS: The answer is yes?

19 MR. BORODOCH: Yes. Even if one were to do so, again,
20 extending the concept of a sender, whether it was a device or not, to
21 incorporate what is disclosed by Foladare and then to render obvious the
22 claimed invention would not make sense at all if one focuses on the claim
23 language.

24 Again, the centralized e-mail device in Foladare simply is not
25 part of the sender or sender device under any reasonable interpretation of
26 Foladare. It's on the other side of a network, completely independent of
27 what the sender does.

28 JUDGE LUCAS: We understand your point. Are there any
29 other issues that you would care to raise before Mr. Borodoch moves on?

30 (No response.)

31 JUDGE LUCAS: Okay.

1 MR. BORODOCH: The Examiner also rejected some of the
2 dependent claims as obvious from Foladare, Redpath and Beck, and further
3 in view of a fourth reference, Ulrich. Ulrich, like the other references, fails
4 to disclose or render obvious a method in which the recipient side impacts
5 transmission processes at the sender side.

6 Ulrich discloses e-mail synchronization between a desktop
7 computer and a mobile device. According to Ulrich, a user of a mobile
8 device may wish to receive only certain attachments or e-mail messages
9 chosen by the user dynamically on an ad hoc basis or chosen according to
10 pre-selected filtering criteria.

11 Ulrich discloses further that the user can decide to download an
12 attachment during synchronization. Synchronization is a specific process of
13 coupling the mobile device and a desktop device such that the two devices
14 can contain the same updated information.

15 The desktop computer and the mobile device interact at the
16 recipient side and thus, the transmission process at the sender's side is not
17 influenced. In other words, Ulrich, like the other references, fails to disclose
18 or render obvious a method in which the recipient side impacts transmission
19 processes at the sender's side.

20 The dependent claims rejected in view of Ulrich are patentable
21 for another reason as well. These claims recite the additional features that
22 the profile created by the recipient can specify that the recipient is not to
23 receive attachments during a particular time frame. Neither Ulrich or the
24 other references disclose or render obvious the subject matter of these
25 dependent claims.

26 With respect, for example, to Claim 43, the Examiner
27 acknowledged that the combination of Foladare, Redpath and Beck does not
28 explicitly teach a profile that specifies that a recipient is not to receive
29 attachments during a particular time. Instead, the Examiner relies on Ulrich,
30 which discloses that a field on a mobile device can indicate whether an
31 e-mail includes an attachment and whether the attachment is scheduled to be
32 downloaded.

1 However, there is no disclosure relating a scheduled
2 synchronization through a profile that specifies the recipient is not to receive
3 attachments during a particular time frame.

4 The Examiner's Answer also points to another portion of Ulrich
5 at Column 12, line 33, which states that the user of a mobile device can
6 select a parameter in the user profile to automatically send all attachments or
7 some of the attachments or no attachments.

8 The Examiner's Answer argues that if the none option is
9 chosen, then no attachments will be downloaded at the next synchronization.

10 The Examiner argues that this is "functionally equivalent to the recipient not
11 receiving attachments during a particular time frame."

12 That is incorrect for several reasons. First, according to Ulrich,
13 even if the user of the mobile device selects to have none of the attachments
14 sent automatically, the user profile fails to specify a particular time frame
15 during which attachments will not be sent. Instead, attachments will not be
16 sent at any time.

17 Furthermore, the Examiner's Answer improperly refers to
18 functionally equivalent as being the standard under Section 103. Functional
19 equivalency is not the proper standard for obviousness under that section.

20 In any event, Ulrich does not disclose assigning specific time
21 frames to any restriction on receiving e-mail attachments.

22 Accordingly, the rejections of the dependent claims based on
23 Ulrich should be reversed for these additional reasons as well.

24 Thank you.

25 JUDGE LUCAS: Are there any questions on chapter two?

26 (No response.)

27 JUDGE LUCAS: Did you want to summarize?

28 MR. BORODOCH: In summary, for all the reasons identified
29 in the Appeal Brief and Reply Brief and today at the hearing, we would urge
30 the Board to reverse all the rejections and allow all the claims, and thank you
31 very much for your time.

Appeal 2010-000728
Application 09/855,584

1 JUDGE LUCAS: Thank you very much for coming in, Mr.
2 Borodoch.

3 JUDGE STEPHENS: Thank you.

4 JUDGE SIU: Thank you.

5 MR. BORODOCH: Thank you.

6 Whereupon, at 10:58 a.m., the proceedings were concluded.

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23